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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,774	01/09/2001	Howard M. Dintzis	07265-124005	8467

7590 10/23/2002

GREGORY P. EINHORN
Fish & Richardson P.C.
Suite 500
4350 La Jolla Village Drive
San Diego, CA 92122

EXAMINER

SAUNDERS, DAVID A

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

157,774

Applicant(s)

DINTZIS et al

Examiner

SAUNDERS

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 44-87 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 44-87 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Int review Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The preliminary amendment of 1/9/01 has been entered. Claims 44-87 are pending and subject to restriction.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 44-69, drawn to methods of making non immunogenic constructs involving the prior preparation of a nonimmunogenic carrier by removing high molecular weight carrier molecules, classified in class 424, subclass 184.1+.
- II. Claims 70-86, drawn to methods of making nonimmunogenic constructs involving a post coupling step of removing high molecular weight molecules therefrom, classified in class 424, subclass 184.1+.
- III. Claim 87, drawn to a non-immunogenic construct, classified in class 424, subclass 184.1+.

The methods of Groups I and II while having the same classification and while producing like products, are considered patentably distinct because a disclosure of one would not necessarily suggest the other. Further the motivations to conduct prior or post coupling purifications to remove high molecular weight molecules would differ. For example, the purification of the carrier preparation per se (Group I) would appear to be the simplest method and would lead to less loss of coupled product, that might include a difficult-to-obtain epitope. The purification of the coupled product would thus not be motivated. Alternatively, if the coupling reaction were to unexpectedly lead to the formation of cross coupled carriers, then one might obtain an unexpected advantage by conducting a post-coupling purification (Group II).

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Furthermore, from the above considerations the claims of Group II, but not of Group I, might be considered as subject to an obviousness type double patenting rejection type double patenting rejection over the claims of Pat. No. 6,340,460.

The product of Group III is considered distinct from the methods of preparation of Groups I and/or II. It is noted that applicant separately prosecuted method of making and product claims in Pat. Nos. 6,340,460 and 6,375,951, respectively. Thus claims of the different Groups instantly pending might be subject to obviousness type double patenting rejections over different lineage(s) of issued patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, Ph.D., whose telephone number is (703) 308-3976. The examiner can normally be reached on Mon.-Thu. from 8:00 a.m. to 5:30 p.m. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3704.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

D. Saunders:jmr

October 7, 2002

David A Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182/1644



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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COMMENTS: _____

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